

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Darren KIDNEY) Group Art Unit: 3617
)
Appln. No. : 10/590,698) Examiner: J. R. Bellinger
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Filed : August 25, 2006) Confirmation No.: 4508
)
For : SEALING RING FOR A VEHICLE WHEEL

REPLY BRIEF UNDER 37 C.F.R. 41.41(a)(1)

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop **Appeal Brief - Patents**
Randolph Building
401 Dulany Street
Alexandria, VA 22314
Sir:

This Reply Brief is in response to the Examiner's Answer dated May 13, 2010, the period for reply extending until July 13, 2010.

In the Examiner's Answer, the Examiner withdraws the Section 112, 2nd paragraph, rejection of claims 13-37. Thus, only the obviousness grounds of rejection advanced in the final rejection of claims 13-24 and 26-28 form the subject of the instant Appeal. The Examiner also provides arguments traversing the arguments presented by Appellant in the Appeal Brief.

Appellant notes this Reply Brief is being filed under 37 C.F.R. 41.41(a)(1) and is directed to the arguments presented in the Examiner's Answer, and therefore must be entered unless the final rejection is withdrawn. Appellant is addressing points made in the Examiner's Answer and not repeating the arguments set forth in the Appeal Brief.

POINTS OF ARGUMENT

First Issue

On page 3 of the Examiner's Answer, the Examiner explains that the Section 112, 2nd paragraph, rejection of claims 13-37 is withdrawn.

Appellant acknowledges the rejection under 35 U.S.C Section 112, 2nd paragraph, is moot.

Second Issue

On page 6 of the Examiner's Answer, the Examiner explains that the Section 132 Objection was withdrawn in the Advisory Action.

Appellant acknowledges the Section 132 Objection is moot.

Third Issue

Appellant wishes to clarify the status of claims 27 and 28. These claims depend from claims 21 and 24, and like claims 21 and 24, stand or fall with claim 13, and with the claims that depend from claim 13.

Fourth Issue

On pages 6 and 7 of the Examiner's Answer, the Examiner maintains asserts that a fair combination of the teachings of GB '784 (Dunlop) and DE '738 (Servaes) teaches the recited deformable sealing elements projecting from each arm. The Examiner's argument appears to be that:

(1) the grooves 8 of GB '784 define deformable sealing elements on GB '784

such that GB '784 teaches deformable sealing elements;

- (2) although the deformable sealing elements of GB '784 do not project from the arms 7 when the member 5 is in an uninstalled state, it would have been obvious to modify the arms 7 of GB '784 to use projections;
- (3) because the device 4 in DE '738 teaches to use projections, one of ordinary skill in the art would modify the arms 7 of GB '784 so as to use the projections DE '738.

This argument may sound reasonable in the abstract, but fails to persuade when one takes full account of the claim language and the actual teachings of the applied art.

Claim 13 recites inter alia, that, when the sealing ring is in an un-installed state, the deformable sealing elements are arranged on and project from a radially inwardly pointing surface of each annular limb so as to extend over a circumference of the annular limb.

GB '784 only shows what the ring 5 looks like in an installed state and with the tire under pressure. Although GB '784 explains that the arms 7 and grooves 8 function to provide sealing (see page 2, lines 21-39), there is no basis or disclosed need in GB '784 to modify such an arrangement so as to use projections. The member 4 in DE '738 applies an essentially axial force to axial annular surfaces of the beads 2 of the tire. Indeed, the member 4 lacks any annular limbs. Moreover, the projections are oriented essentially axially and serve to apply essentially axial forces against the tire beads so as to compress them between the member 4 and the rim 3. In this sense, they are not deformable sealing members in accordance with the invention, i.e., these projections cannot be said to be arranged on and project from a radially inwardly pointing surface of each annular limb.

Because GB '784 shows complete sealing contact between the arms 7 and the sidewalls 6 (except for the grooves 8), modifying such an arrangement to use projections extending from the radially inward surface toward the inner surface of the tire would appear to reduce the sealing contact because it is not apparent that the arms would continue to lay flat against the inner surface of the tire, as intended by GB '784, if provided with the projections of DE '738. Thus, one could probably more reasonably argue that GB '784 teaches away from using the projections of DE '738 as to argue for their incorporation. Nor is there any suggestion that using projections on the arms 7 in GB '784 would provide better sealing or even provide such sealing at all. GB '784 teaches to make the arms 7 relatively long (extending along way up the sidewalls 6) and with tapered ends. In Appellant's invention, the arms are significantly different, i.e., they are shown as much shorter and with thicker ends (see Figs. 4-6). The arrangement of GB '784 would therefore presumably provide all of the necessary sealing contact without any need to use projections.

Such a modification also raises questions such as where prior art would suggest placing the projections. The arms 7 in GB '784 are intentionally made tapered so as to be more flexible at the ends (see page 2, lines 26-29). Thus, adding projections to the arms 7 would likely reduce their flexibility, i.e., would not such projections function as circumferential reinforcements?

Perhaps a more appropriate modification would be to use the projections of DE '738 on the sides of section 5a in GB '784 (as it is the section 5a which functions in the same manner as the member 4 in DE '738 to maintain a seating position of the beads) instead of

being arranged on the arms 7, as suggested by the Examiner. However, this is not what the Examiner's alleges and, of course, would not satisfy the requirements of the independent claims.

Fifth Issue

On page 7 of the Examiner's Answer, the Examiner asserts that Appellant is attacking the reference separately or individually. Appellant respectfully disagrees. Appellant has merely consistently argued why it would not be obvious to use the projections of DE '738 on the device of GB '784. Although Appellant has discussed the actual teachings and deficiencies of each document, this is hardly an attack on the reference separately or individually, but rather identifies the disparate teachings and unrelated structure, and uses of the elements described in the applied art.

Indeed, in the Appeal Brief, Appellant has specifically addressed the merits (or lack thereof) of the asserted combination. For example, it was noted that whereas the grooves 8 of GB '784 press against a portion of the tire along a generally radial direction whose force vector intersects an outer circumferential portion of the rim 1, the so-called deformable members or projections of the member 4 in DE '738 press against a portion of the tire along an axial direction whose force vector does not intersect an outer circumferential portion of the rim.

Sixth Issue

On pages 7 and 8 of the Examiner's Answer, the Examiner asserts that "[t]he fact that the sealing elements of Servaes [DE '738] extend axially is irrelevant" because GB '784

is relied upon to teach using sealing elements in the recited locations. Appellant respectfully disagrees. The Examiner is not free to pick and choose features from one document to add to an other in any manner he desires. There must be some basis for making the asserted combination or modification.

The fact that the projections in DE '738 are oriented axially is very relevant as the Examiner is seeking to use essentially axial projections on essentially circumferential surfaces. Also relevant is the fact that DE '738 shows a member 4 with no arms, wings, or annular limbs.

As explained in the Appeal Brief, the asserted combination/modification is improper because the features of each document function differently, i.e., the member 4 of DE '738 with the so-called deformable members or projections is wedged into position between the tire beads so as to be oriented axially to bias the tire beads axially outwardly to seat the beads in the rim whereas the grooves on member 5 of GB '784 point down towards the inner surface of the tire above the beads and appear to play no role in biasing the tire beads axially outwardly to seat the beads in the rim. Moreover, it appears to be the center portion 5a in GB '784 (not the wings 7) which biases the tire beads axially outwardly to seat the beads in the rim.

The orientation of the projections of DE '738 is also relevant because it is Appellant's contention that none of the applied documents even remotely disclose or suggest that the deformable sealing elements are arranged on and project from a radially inwardly pointing surface of each annular limb. Again, the sealing member 5 shown in GB '784 shows grooves

8 arranged in the wings 7, but nothing projecting from a radially inwardly pointing surface of each annular limb. Similarly, the sealing member 4 shown in DE '738 shows projections arranged in axial end surfaces, but not on any wings, and these projections clearly do not project from a radially inwardly pointing surface of each annular limb.

Seventh Issue

On page 8 of the Examiner's Answer, the Examiner asserts that he may properly interpret claim 20 in a manner which renders the radial elevation of claim 20 obvious. Appellant respectfully disagrees and submits that the Examiner has taken an overly broad interpretation of the claim language that is inconsistent with *In Re Suitco* 603 F.3d 1255 (Fed. Cir. 2010).

Appellant notes that, e.g., Fig. 12 of the instant application shows a hollow space 38 arranged in a radial elevation 37. Claim 20 specifically requires a radial elevation and a hollow space therein. None of the applied documents teaches this feature.

While it is true that MEDYNSKI teaches a hollow space, the hollow space in MEDYNSKI is arranged in a center portion of sealing element 12 and not in a radial elevation of the member 12. It is noted that the rounded radial elevation above the hollow space of member 12 in Fig. 1 has no hollow space arranged therein. This is unlike the invention which utilizes a radial elevation 37 that has a hollow space 38 arranged therein (see Fig. 12 of Appellant's specification.

Eighth Issue

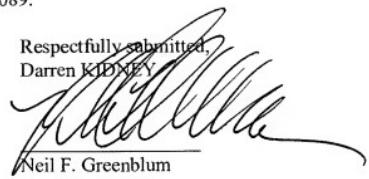
In the Examiner's Answer, the Examiner never addresses Appellant's arguments

regarding claims 14-16 and 22 in Section (10). This is not surprising given that the Examiner has improperly rejected these features on the basis of mere conclusions of obviousness.

CONCLUSION

Accordingly, in view of the above-noted arguments (as well as those already of record), the Board is respectfully requested to reverse the Examiner's decision to finally reject claims 13-24 and 26-28 under 35 U.S.C. § 103, and that the application be remanded to the Examiner for withdrawal of the rejection over the applied documents and an early allowance of all claims on appeal. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 19-0089.

Respectfully submitted,
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